APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/467,387	12/21/1999	EDUARDO PELEGRI-LLOPART	SUN1P253/P41	2336

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EXAMINER
KISS, ERIC B

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _21 December 1999_ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-25_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-25_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _21 December 1999_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _5_ .	6) ☐ Other: .

DETAILED ACTION

1.   Claims 1-25 have been examined.

Drawings

2.   Figures 2 and 4 should be designated by a legend such as --Prior Art-- because only that

which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected

drawings are required in reply to the Office action to avoid abandonment of the application. The

objection to the drawings will not be held in abeyance.

3.   The drawings are object to because Figure 2 does not clearly illustrate the details of the

second interface (indicated with the shorter of the two vertical bars). It is unclear whether this is

intended to show a request object to container interface as described in page 2, lines 5-9 or a

container to JSP Page interface as described in page 2, lines 10-12. Since the vertical bar

representing this interface stops before reaching the "Container" label, it is not clear whether this

label is to be assumed to lie to the right of this interface in the figure. It is furthermore unclear

whether or not there is any significance in the ovals around "request" and "response" by the

second interface.

Applicant is required to submit a proposed drawing correction in reply to this Office

action. However, formal correction of the noted defect may be deferred until after the examiner

has considered the proposed drawing correction. Failure to timely submit the proposed drawing

correction will result in the abandonment of the application.

Specification

4.   The use of trademarks JAVA, JAVA BEAN, JAVASERVER, COLDFUSION,

LIVESOFTWARE, and JRUN has been noted in this application. They should be capitalized

wherever they appears and be accompanied by the generic terminologies.

Although the use of trademarks is permissible in patent applications, the proprietary

nature of the marks should be respected and every effort made to prevent their use in any manner

which might adversely affect their validity as trademarks.

5.   The disclosure is objected to because of the following informalities: all instances of the

term "Boolean" should be capitalized.

Appropriate correction is required.

Claim Objections

6.   Claims 4, 6, 15, and 22 are objected to because of the following informalities:

All instances of the term "Boolean" should be capitalized. Appropriate correction is

required.

Claim 22 recites **"goto (e)"** in line 9. While "goto" is a generally well-understood

programming language instruction specifying a transfer of execution to another statement and the

term also appears in some algorithm descriptions as a shorthand notation (as claim 22 appears to

be), Applicant should revise the claim to recite the limitations in more formal language.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

8.   Claims 12 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the enablement requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to enable one skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention. The specification does not

provide a sufficient description of "closures" to clearly define what the claimed terminology

"entire closure context" is intended to mean. Further, Fig. 4 is relied upon as illustrating how a

tag can be translated into a closure (see column 5, line 7), however, Fig. 4 appears to be a JAVA

programming language implementation, and the specification further indicates that the JAVA

programming language does not support the use of closures (see column 5, lines 20-21). An

incomplete description of a "closure" precludes one from knowing when a closure is not used.

One of ordinary skill in the art would not be able to discern from the limited illustration and

description exactly what components would necessarily constitute an entire closure context and therefore, would not be able to make and/or use the claimed invention.

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10.   Claims 2, 3-8, 10-12, 16, 20, 22, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "**the body**" in line 1. There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, this limitation is subsequently interpreted as reading "**a body**" for the purpose of further examination.

Claims 10, 16, 20, and 22 contain the trademark/trade name JAVA BEAN and/or JAVASERVER. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe specific programming language components and, accordingly, the identification/description is indefinite.

Claim 25 recites the limitation **"the scripting language"** in lines 5-6. There is

insufficient antecedent basis for this limitation in the claim.

Further, the final limitation of claim 25, recited in lines 5-6, is not a positively recited

active method step. This limitation instead appears to state a capability of the claimed invention,

or its intended user, in terms of negative limitations that are not necessarily natural results of the

previously recited method steps.

Claims 3-8 and 12 are rejected based on parent claim limitations recited in claim 2 and

rejected as set forth above.

Claim 11 is rejected based on inherited parent claim limitations recited in claim 10 and

rejected as set forth above.

Claim Rejections - 35 USC § 101

11.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

12.   Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.

As per claims 1-12, merely claimed as a computer program representing a computer

listing *per se* (mechanism), that is, descriptions or expressions of such a program and that is,

descriptive material *per se*, non-functional descriptive material, and is not statutory because it is

not a physical "thing" nor a statutory process, as there are not "acts" being performed. Such

claimed computer programs do not define any structural and functional interrelationships

between the computer program and other claimed aspects of the invention which permit the

computer program's functionality to be realized. Since a computer program is merely a set of

instructions capable of being executed by a computer, the program itself is not a process, without

the computer-readable medium needed to realize the computer program's functionality. In

contrast, a claimed computer-readable medium encoded with a computer program defines

structural and functional interrelationships between the computer program and the medium

which permit the computer program's functionality to be realized, and is this statutory.

Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200

USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14.   Claims 1-8, 13-15, 17-19, 21, 23, and 25 are rejected under 35 U.S.C. 102(b) as being

anticipated by Andrew C. Staugaard, Jr., "Structured and Object-Oriented Techniques, An

Introduction Using C++," 1997, Prentice Hall, Inc. (hereinafter *Staugaard*).

As per claims 1, 13, 23, and 25, Staugaard discloses a doStart() method (see, for example, "Input.open(FileName);" in line 5 of page 655); a doBody() method (see, for example, "Input >> Line" in line 18 of page 655); and a doEnd() method (see, for example, "Input.close();" in line 21 of page 655).

As per claims 2 and 14, *Staugaard* further discloses a body being evaluated as a BodyEvaluation object, which is passed into the doBody() method (the "Input >> Line;" function of page 655, line 18 writes stream data into a line buffer named "Line").

As per claims 3 and 17, *Staugaard* further discloses the doBody() method returning "true" if more body evaluations are needed (see, for example, "while (!Input.eof())" in line 15 of page 655; "!Input.eof()" returns true if the end of the input file has not yet been reached).

As per claims 4 and 5, *Staugaard* further discloses the doStart() method returning a Boolean value (the value of Input is checked in line 6 of page 655 to see if the file can be opened). Note that Boolean values are specialized integer values (see, for example, the subsequent discussion of the "eof()" function on page 655).

As per claims 6 and 15, *Staugaard* further discloses the doStart() method being first invoked with attribute value data (see, for example, "FileName" in line 5 of page 655), and returning a Boolean value indicating if a body needs to be evaluated (the value of Input is checked in line 6 of page 655 to see if the file can be opened).

As per claims 7 and 18, *Staugaard* further discloses a doEnd() method being evaluated when no more body evaluations are needed, and scripting variables are synchronized (the "Input.close();" method is evaluated (line 21 of page 655) when the entire file has been read and its entire contents have been displayed).

As per claims 8 and 19, *Staugaard* further discloses insertion and extraction operations

being nested within (subfunctions of) a while loop (see, for example, lines 15-19 of page 655).

As per claim 21, *Staugaard* further discloses a doInitBody() method which is executed

only during the first iteration of the body evaluation (see, for example, lines 12-13 of page 655).

Claim Rejections - 35 USC § 103

15.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

16.   Claims 9-11, 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Andrew C. Staugaard, Jr., "Structured and Object-Oriented Techniques, An Introduction Using

C++," 1997, Prentice Hall, Inc. (hereinafter *Staugaard*) in view of "JAVASCRIPT Reference,"

1997, Netscape Communications Corp. (hereinafter *JSRef*).

As per claims 9 and 24, *Staugaard* discloses such a mechanism (see disclosure applied to

claim 1), but fails to expressly discloses a tag structure corresponding to an original scripting

page being preserved during a page translation . However, *JSRef* teaches the JAVASCRIPT

scripting language, a cross-platform, object-based scripting language for client and server

applications (see page 1, paragraph 1). *JRef* further teaches server-side JAVASCRIPT as being

embedded in HTML pages and compiled into bytecode executable files. When a JAVASCRIPT

application is requested by a client browser, the runtime engine generates an HTML page to

return (see "Server-Side JAVASCRIPT" on pages 9-11). As shown in the examples shown in

Figs. 1.3 and 1.4, the overall tag structure is preserved. *JSRef* further teaches a File object,

which lets a JAVASCRIPT application interact with a physical file on the server (see page 14,

lines 1-2). The File object taught by *JSRef* includes substantially similar methods as that of the

fstream object disclosed by *Staugaard*, and *JSRef* illustrates a similar use on pages 16-17.

JAVASCRIPT has a distinct advantage over the C/C++ language implementation disclosed by

Staugaard in that it allows for cross-platform interaction between a client and server, implying

that many different types of client platforms can access the same server-side application.

Therefore, it would have been obvious to one having ordinary skill in the computer art at the

time the invention was made to modify the mechanism of *Stauggard* to implement the operations

within an HTML web-page environment in which a page containing tags is translated while

preserving the tag structure as per the teachings of *JSRef*. One would be motivated to do so to

gain the advantage of cross-platform client-server portability.

As per claims 10 and 20, in addition to the disclosure and teachings applied above, the

JAVASCRIPT application comprises a text-based document that describes how to process a

request to create a response (see *JSRef*, "Server-Side JAVASCRIPT" on pages 9-11; and

Applicant's definition of a JAVASERVER PAGE on page 1, in lines 19-21 of the instant

specification). The motivation for implementing the *Staugaard* methods using the

JAVASCRIPT scripting language have already been stated above with respect to claims 9 and

24. Therefore, for reasons stated above, such claims also would have been obvious.

As per claim 11, in addition to the disclosure and teachings applied above, the examples disclosed by *JSRef* in Figs. 1.3 and 1.4 illustrate the use of form buttons to control data transfer between client and server as well as to initiate further processing of data. The motivation for implementing the *Staugaard* methods using the JAVASCRIPT scripting language have already been stated above with respect to claims 9 and 24. In addition one having ordinary skill in the computer art would be motivated to a method that returns a value indicating whether to continue processing a page in order to control data transfer within a client-server application efficiently. Therefore, for these reasons stated above, such claims also would have been obvious.

Conclusion

17.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Kiss whose telephone number is (703) 305-7737. The examiner can normally be reached on Tue. - Fri., 7:30 am - 5:00 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (703) 305-4552.

Any response to this action should be mailed to:
Commissioner for Patents
P.O.Box 1450
Alexandria,VA 22313-1450

Or faxed to:
 (703) 746-7239 (for formal communications intended for entry)
Or:
 (703) 746-7240 (for informal or draft communications, please label
 "PROPOSED" or "DRAFT")
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA, 22202, Fourth Floor (Receptionist).

 Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-3900.

EBK
July 28, 2003

KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
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